

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN TERLIZZI

Appeal No. 98-0464
Application 08/554,386¹

ON BRIEF

Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John Terlizzi appeals from the final rejection of claims 1 through 16, all of the claims pending in the application.

¹ Application for patent filed November 6, 1995. According to appellant, the application is a continuation of Application 08/210,352, filed March 18, 1994, now abandoned.

We reverse.

The invention relates to "a shoe with a split sole, particularly useful as a dance shoe, but also useful as an exercise shoe, and particularly relates to sag and stretch resistance of the mid-section of the shoe between its split sole regions" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A shoe comprising:

a shoe upper including a bottom beneath, sides passing up past the sides of, and a top above a wearer's foot; the shoe upper including a front portion, a heel portion and a foot opening at the heel portion; the shoe upper being comprised of a flexible material at least at the mid-section of the shoe upper;

a split sole beneath the bottom of the shoe upper including a front sole portion under the front portion of the shoe upper, a rear sole portion under the heel portion of the shoe upper, a mid-section of the bottom of the shoe upper between the front and the rear sole portions and which is without the sole beneath it;

a band of flexible, non-stretchable material attached to the shoe upper so as to overlap the shoe upper at the mid-section of the shoe upper, the band extending across the bottom of the shoe upper, up past both sides of the shoe upper and extending to and attached in an overlapping arrangement to both sides of the shoe upper toward the top of the shoe upper for substantially reducing an amount of sagging of the bottom

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of the shoe upper due to application of force to the bottom of the shoe upper by the wearer's foot and due to stretching of the shoe upper material.

The items relied upon by the examiner as evidence of anticipation and obviousness are:

Glidden	2,147,197	Feb. 14, 1939
Whitman	2,539,761	Jan. 30, 1951
Misevich et al. (Misevich)	4,542,598	Sept. 24, 1985
Brown	4,813,158	Mar. 21, 1989

Claims 1 through 6, 9, 10, 15 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Misevich.

Claims 1 through 6, 9 through 13, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misevich in view of Brown.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misevich in view of Whitman.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Misevich in view of Glidden.

Reference is made to the appellant's main and reply

briefs (Paper Nos. 16 and 19) and to the examiner's answer (Paper No. 17) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.²

Turning first to the standing 35 U.S.C. § 102(b) rejection of claims 1 through 6, 9, 10, 15 and 16, Misevich discloses an athletic shoe constructed to allow independent movement of the wearer's forefoot and heel. To this end, the shoe comprises spaced forefoot and rearfoot sole units 12 and 14 joined by a flexible and pliable upper 10. The midfoot portion of the upper defines "a highly flexible, soleless, universal coupling between the two sole units to allow virtually unrestrained relative motion between the wearer's heel and forefoot" (column 2, lines 50 through 53). Of the particular make-up of the midfoot portion, Misevich teaches that

[t]he upper is . . . formed with a pliable wrap-around saddle [31] which extends along the sides and

² The 37 CFR § 1.132 declaration of Dennis Stevens (Paper No. 18) which was submitted by the appellant with the reply brief has been refused entry by the examiner (see Paper No. 20). Accordingly, we have not considered this declaration in reviewing the examiner's rejections.

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all the way around the bottom of the soleless midfoot region between the forefoot and rearfoot sole units. When the shoe is laced up, the saddle provides a secure girth-like grip around the foot in the midfoot region and flexibly hugs the foot just in the midfoot region without constraining the natural motions of the different parts of the foot [column 3, lines 35 through 43].

The saddle 31 can be made of any suitable flexible material such as vinyl or leather (see column 5, line 62, through column 6, line 10).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert denied, 468 U.S. 1228. It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's determination that the shoe recited in independent claim 1 is anticipated by Misevich rests in part

on the proposition that the claim limitation relating to the "band of flexible, non-stretchable material" reads on Misevich's "vinyl" saddle 31 because "vinyl would appear [to] be a non-stretchable material" (answer, page 5). Misevich, however, is completely silent as to whether the saddle, be it made of vinyl or leather, is stretchable or not, and provides no other reasonable support for the examiner's position. Since the Misevich shoe does not include any other structure meeting the claim limitation at issue, Misevich cannot be said to disclose, expressly or under principles of inherency, each and every element of the invention recited in claim 1.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1, or of claims 2 through 6, 9, 10, 15 and 16 which depend therefrom, as being anticipated by Misevich.

As for the standing 35 U.S.C. § 103 rejection of claims 1 through 6, 9 through 13, 15 and 16, the examiner's reliance on Brown to overcome the foregoing deficiency in Misevich is not well taken.

Brown discloses an athletic shoe having an upper 10 which includes reinforcing members 30 and 32 extending from the sole

12 to the lacing margin 20 of the shoe to provide lateral support for the wearer's foot. The reinforcing members are made of a flexible and non-stretchable material such as nylon (see the Abstract; column 1, lines 43 through 57; column 2, lines 24 through 35; and column 3, lines 42 through 52).

According to the examiner,

[a]ssuming arguendo that vinyl is NOT a non-stretchable material, as claimed by Appellant, Brown shows that nylon reinforcing straps are an equivalent structure known in the art. Therefore, because these two reinforcing materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the nylon material of Brown for the leather or vinyl reinforcing saddle of Misevich et al. because nylon provides a high degree of support for the foot and which, at the same time, has a long life and will not stretch during use [answer, pages 5 and 6].

To begin with, expedients which are functionally and/or mechanically equivalent to one another are not necessarily obvious in view of one another. See In re Scott, 323 F.2d 1016, 1019, 139 USPQ 297, 299 (CCPA 1963). Moreover, Misevich's saddle 31 and Brown's reinforcing members 30 and 32 have little, if any, functional and/or mechanical equivalence. Misevich's saddle 31 is designed to afford a highly flexible and universal coupling between spaced sole units to permit

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virtually unrestrained relative motion between the wearer's heel and forefoot. Brown's reinforcing members 30 and 32, on the other hand, are designed to provide lateral support in a shoe having but a single sole unit. The only suggestion for combining these rather disparate teachings in the manner proposed by the examiner stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Therefore, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or of claims 2 through 6, 9 through 13, 15 and 16 which depend therefrom, as being unpatentable over Misevich in view of Brown.

Since neither Whitman nor Glidden cures the above noted shortcoming of Misevich with respect to subject matter set forth in independent claim 1, we also shall not sustain the standing 35 U.S.C. § 103(a) rejections of dependent claims 7 and 8 as being unpatentable over Misevich in view of Whitman and claim 14 as being unpatentable over Misevich in view of Glidden.

The decision of the examiner is reversed.

REVERSED

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JAMES M. MEISTER)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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